

REMARKS

The Office Action dated June 23, 2008, has been received and carefully considered. In this response, claims 48-55 have been amended and claims 56-57 have been added. No new matter has been added. Entry of the amendments to claims 48-55 and the addition of claims 56-57 is respectfully requested. Reconsideration of the current rejections in the present application is also respectfully requested based on the following remarks.¹

I. THE OBVIOUSNESS REJECTION OF CLAIMS 48, 49, 52, AND 53

On pages 3-7 of the Office Action, claims 48, 49, 52, and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Postrel (U.S. Patent Application Publication No. US2004/0220854A1) in view of Barnett et al. (U.S. Patent No. 6,321,208), the GMA Press Release (GMA, Joint Industry Coupon Committee Unveil Comprehensive New Report on Couponing; Study Offers Key Learnings, Voluntary Guidelines to Make Process More

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions made by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Efficient, Effective), and Ewoldt (Clip & save these tips).
This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some "reason that would have prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if

there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Regarding claim 48, the Examiner asserts that the claimed invention would have been obvious in view of Postrel, Barnett et al., the GMA Press Release, and Ewoldt. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has amended claim 48 to more specifically define the claimed invention, and specifically those features that differentiate the claimed invention from Postrel, Barnett et al., the GMA Press Release, and Ewoldt, as well as the other cited references. Support for the amendments may be found in the specification at paragraphs [0005], [0012], [0086], [0087]. In particular, Applicant respectfully submits that Postrel, Barnett et al., the GMA Press Release, and Ewoldt, either alone or in combination, fail to disclose, or even suggest, a method wherein manufacturers and consumers both interface with a separate host computer in a 3-party system resulting in the generation of a 3-party manufacturer coupon, which is generated by the host computer as directed by a manufacturer and distributed to a physical address of a registered consumer using the host computer as directed by the manufacturer, such that the 3-party manufacturer coupon may be redeemed at a separate retailer by the registered consumer, as presently claimed. In contrast, as detailed in Applicant's

prior responses and inventor declaration, Postrel, Barnett et al., the GMA Press Release, and Ewoldt, either alone or in combination, simply disclose, at best, 2-party systems involving only retailers and consumers. Indeed, Postrel, Barnett et al., the GMA Press Release, and Ewoldt, either alone or in combination, fail to disclose, or even suggest, a separate host computer that interfaces with both manufacturers and consumers in a 3-party coupon system, generates a 3-party manufacturer coupon at the direction of manufacturer, and is used to distribute the 3-party manufacturer coupon to a physical address of a registered consumer as directed by the manufacturer, such that the 3-party manufacturer coupon may be redeemed at a separate retailer by the registered consumer, as presently claimed. Accordingly, is it respectfully submitted that claim 48 is allowable over Postrel, Barnett et al., the GMA Press Release, and Ewoldt, either alone or in combination.

At this point Applicants would like to respectfully remind the Examiner that, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382 (CCPA 1970). Also, as stated in MPEP § 2143.01, if the proposed

modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810 (CCPA 1959). Thus, in addition to failing to disclose, or even suggest, all of the limitations of claim 48 as discussed above, any combination of Postrel, Barnett et al., the GMA Press Release, and Ewoldt to arrive at the claimed invention would also result in an improper modification of one or more of these references since none of these references actually disclose a 3-party coupon system.

Regarding claim 49, claim 49 is dependent upon independent claim 48. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). Thus, since independent claim 48 should be allowable as discussed above, claim 49 should also be allowable at least by virtue of its dependency on independent claim 48. Moreover, claim 49 recites additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. For

example, claim 49 recites a separate host computer that interfaces with manufacturers, consumers, and retailers in a 3-party coupon system, generates a 3-party retailer coupon at the direction of retailer, and is used to distribute the 3-party manufacturer coupon to a physical address of a registered consumer as directed by the retailer, such that the 3-party retailer coupon may be redeemed at the retailer by the registered consumer, as presently claimed.

Regarding claims 52 and 53, these claims recite subject matter related to claims 48 and 49, respectively. Thus, the arguments set forth above with respect to claims 48 and 49 are equally applicable to claims 52 and 53. Accordingly, is it respectfully submitted that claims 52 and 53 are allowable over Postrel, Barnett et al., the GMA Press Release, and Ewoldt, either alone or in combination, for the same reasons as set forth above with respect to claims 48 and 49.

At this point it should be noted that claims 56 and 57 have been added to separately recite limitations regarding consumer selection of coupons that were previously included in claims 48 and 52, respectively.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 48, 49, 52, and 53 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 50, 51, 54, AND 55

On pages 7-8 of the Office Action, claims 50, 51, 54, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Postrel (U.S. Patent Application Publication No. US2004/0220854A1) in view of Barnett et al. (U.S. Patent No. 6,321,208) the GMA Press Release (GMA, Joint Industry Coupon Committee Unveil Comprehensive New Report on Couponing; Study Offers Key Learnings, Voluntary Guidelines to Make Process More Efficient, Effective), and Ewoldt (Clip & save these tips), and further in view of Gupta et al. (U.S. Patent No. 6,820,062). This rejection is hereby respectfully traversed.

It is respectfully submitted that the aforementioned obviousness rejection of claims 50, 51, 54, and 55 has become moot in view of the deficiencies of the primary references (i.e., Postrel, Barnett et al., the GMA Press Release, and Ewoldt) as discussed above with respect to independent claims 48 and 52. That is, claims 50, 51, 54, and 55 are dependent upon independent claims 48 and 52 and thus inherently incorporate all of the limitations of independent claims 48 and 52. Also, the secondary reference (i.e., Gupta et al.) fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claims 48 and 52. Indeed, the Examiner does not even assert such. Thus, the combination of the secondary reference with the primary

references also fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claims 48 and 52. Accordingly, claims 50, 51, 54, and 55 should be allowable over the combination of the secondary reference with the primary references at least by virtue of their dependency on independent claims 48 and 52. Moreover, claims 50, 51, 54, and 55 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 50, 51, 54, and 55 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By: 

Thomas F. Anderson

Registration No. 37,063

TEA/vrp

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

Date: September 23, 2008